

REMARKS

Claims 1 to 19 are now pending.

With respect to paragraph one (1) of the Office Action, claims 1 to 19 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

First, claims 1 to 16 and 19 are to a method -- and not to a program per se.

It is not fully understood why the Examiner is now raising such an objection, since, for example, claims 7 to 9 and 13 to 15 were previously allowed, and since, for example, claims 17 and 18 are not even method claims, since they are apparatus or device claims, and therefore are *per se* statutory claims, as are each of the method claims 1 to 16 and 19 which are directed to a method for operating or diagnosing the operation of an internal combustion engine.

Also, Applicants do not understand why the Examiner is raising this issue in view of the recent Precedential Opinion of the Board of Patent Appeals and Interferences, Ex parte Carl A. Lundgren (paper no. 78), Appeal No. 2003-2088 (U.S. Patent Application Serial No. 08/093,516) (case Heard April 20, 2004). In this Precedential opinion, the Board made plain that any “technological arts” test (which is what the Office Action essentially asserts) is inconsistent with both Federal Circuit and Supreme Court law.

To the extent that the Examiner maintains this rejection in view of Lundgren, it is respectfully requested that the Examiner explain exactly how its rejection is supported in view of the Board’s precedential Lundgren opinion.

Still further, it is respectfully submitted that the rejected claims do satisfy Section 101 since they are directed to a *method (claims 1 to 16 and 19)* or to an *apparatus or device (claims 17 and 18)* which are patentable in each case and which have utility in each case. It is suggested that the Lundgren opinion and the MPEP at 2106 and 2107 (regarding the Examination Guidelines for the utility requirement) makes plain that each of claims 1 to 19 have utility under Section 101. It is also respectfully submitted that the reasons advanced in support of the rejection are simply not supported by either the Examination Guidelines or more importantly the case law, and that a *prima facie* case has not been presented as required by Sections 2106 and 2107 of the MPEP.

In this regard, the Board of Patent Appeals — in reversing another Examiner for ignoring the law of State Street — has stated that claimed subject matter having a “practical application” is § 101 statutory subject matter if the subject matter represents a “useful, concrete and tangible result” under State Street, and has further stated that the Federal

Circuit's reasoning in State Street is "intended to be broadly construed". See Ex parte Donner, 53 U.S.P.Q.2d 1699, 1702 (Bd. Pat. App. & Int. 1999).

It is therefore respectfully requested that the Section 101 rejections of claims 1 to 19 be withdrawn in view of the Lundgren precedential opinion of the Board of Patent Appeals and Interferences (in its *per curiam* opinion), the State Street case, and the MPEP at Sections 2106 and 2107.

As to the Office Action's assertions that the claims do not specify by what device or structure the parameters are determined,, the Federal Circuit -- as well as the U.S. Patent Office -- has not required that method claims recite how the method steps are to be performed. In this regard, in AT&T Corp. v. Excel Communications Inc., 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999), the Federal Circuit stated that the claims of U.S. Patent No. 5,333,184 ("the '184 patent") were plainly directed to § 101 statutory subject matter. See id. at 1452. ("Excel also contends that because the process claims at issue lack physical limitations set forth in the patent, the claims are not patentable subject matter. This argument reflects a misunderstanding of our case law. . . . Since the claims at issue in this case are directed to a process in the first instance, a structural inquiry is unnecessary").

It is further respectfully submitted that the Office Action's focus on the issue of how the method is to be performed is simply not understood in the context of the § 101 inquiry as expressed by the Federal Circuit in State Street and AT&T — and as also expressed by the Donner Board.

It is also noted that the Patent Office has allowed patent method claims even though the method claims used a known logical principal. In refusing to find that a patent did not reflect § 101 statutory subject matter, the Federal Circuit has stated that:

[As] explained, **AT & T's claimed process** employs "subscribers and call recipients" PICs as data, **applies Boolean algebra to those data to determine the value of the PIC indicator. . . .**

In this case, Excel argues . . . that the PIC indicator value is derived using a simple mathematical principle (p and q). **But that is not determinative because AT & T does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the '184 patent that AT & T is only claiming a process that uses the Boolean principle . . . to determine the value of the PIC indicator.** The PIC indicator represents

information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber. **Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101.**

See id. at 1452 (citations omitted; emphasis added).

It is therefore plain that each of claims 1 to 19 is directed to statutory subject matter under 35 U.S.C. § 101. To conclude otherwise would be contrary to the views of the Donner Board — and would be antithetical to the Federal Circuit's actions in both State Street and AT&T.

Also, the concreteness issue raised as to 101 subject matter really goes to definiteness under 35 USC 112, but is not agreed with in any case since the claims are fundamentally definite as to their features as recited in the context of each of the claims, as explained below.

As to a tangible result, such a result is provided in that the error is used to operate or diagnose the operation of an internal combustion engine as provided for in each of claims 1 to 19, as referred to below.

In particular, claims 1 to 16 and 19 are to a method relating to the operation of an internal combustion engine, and are therefore per se statutory. Additionally, independent method claims 7, 8 13 and 14 are to *a method for diagnosing operation of an internal combustion engine having a compressor for compression of air supplied to the internal combustion engine*, and are therefore per se statutory subject matter.

Also, claims 17 and 18 are not even method claims, since they are apparatus or device claims, and therefore are per se statutory claims, as are each of the method claims 1 to 16 and 19 which are directed to a method for operating or diagnosing the operation of an internal combustion engine.

While the rejection of claim 1 may not be agreed with, to facilitate matters, claim 1 has been rewritten, to facilitate matters, to provide that the feature provides for “detecting an error as a function of a result of the comparing *of the ratios*, wherein the error is used to operate the internal combustion engine”. Accordingly, claim 1 as presented is statutory subject matter under 35 USC 101.

In particular, independent method claim 1 and independent device claim 17 each provide that the measured actual pressure ratio is compared with a modeled actual pressure ratio (*and a setpoint pressure ratio* that is to be set in the case of apparatus device claim 18 and dependent method claim 19, as explained below).

As to independent method claim 19 and independent *device* claim 18, the measured actual pressure ratio is compared to a setpoint pressure ratio that is to be set. With the subject matter of independent method claim 19 and independent device claim 18, the measured actual pressure ratio is compared to the setpoint pressure ratio that is to be set -- that is, to the pressure ratio that is to be set by the compressor is the desired compressor pressure ratio. Accordingly, the claims 18 and 19 are allowable for these further reasons.

In summary, claims 1 (and its dependent claims 2 to 16, and 19), and independent apparatus device claims 17 and 18 are allowable for the foregoing reasons.

Claims 2 to 6, 10 to 12, 16 and 19 depend from claim 1 as presented, and are therefore allowable for the same reasons as claim 1 as presented.

It is therefore respectfully requested that the non-statutory subject matter rejections be withdrawn.

It is therefore respectfully submitted that all of claims 1 to 19 are allowable – consistent with the prior allowance of formerly allowed claims 7 to 9 and 13 to 15.

Conclusion

In view of the foregoing, it is believed that the rejections of the claims have been obviated, and that claims 1 to 19 are therefore allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Dated: _____

11/30/2006

Respectfully submitted,
KENYON & KENYON LLP

By: _____

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

1277907